

## REMARKS

The Office Action dated March 18, 2004 has been carefully reviewed. Claims 1-20 are pending in this patent application. By this amendment, claims 21-28 have been added. Reconsideration of this application is respectfully requested.

### 35 U.S.C. § 103 Rejection

Claims 1-20 were rejected under 35 U.S.C. § 103 as being unpatentable over Wildgoose et al. (U.S. Patent No. 5,690,636) in view of Knox (U.S. Patent No. 6,332,887).

### Discussion Regarding Patentability of Claim 11

#### *Claim 11*

Claim 11 reads as follows:

11. A method of surgically preparing a tibia for implantation of a prosthetic implant, comprising the steps of:  
    securing a tray trial to a proximal end of the tibia, wherein the tray trial defines a plate opening therethrough, the plate opening having a center point;  
    advancing a first bone working tool through the plate opening at the center point to form a first hole in the tibia;  
    securing a first guide to the tray trial, wherein the first guide defines a first bore and a second bore, each of the first and second bores having a center point offset from the center point of the plate opening; and  
    advancing a second bone working tool through one of the first bore and the second bore to form a second bore in the tibia.

The invention defined in claim 11 addresses a particular problem in the medical arts. Specifically, a condition which renders surgical preparation relatively difficult is the case in which the tibial canal of the patient's tibia is offset from, or otherwise not coincident with, the center of the tibia. Indeed, it is known

that the anatomy of some patients may create a situation in which the tibial canal of the patient's tibia is offset from the center of the tibia by as much as three to four millimeters (3-4 mm). Such an offset is above and beyond a slight anterior-posterior offset of the tibial canal which is inherent in most patient's anatomies. It should be appreciated that if a tibial implant having a stem which is centered relative to the implant's plate is implanted into a patient's tibia which has an offset tibial canal, undesirable impingement of the stem into contact with the cortical bone of the tibia may result.

Applicants' invention of claim 11 is directed at overcoming, and in fact does overcome, the above-identified problem in the prior art. The Wildgoose reference never acknowledges this problem, much less, attempts to solve it. And the Knox reference, being directed at spinal fusion, is entirely unconcerned with this problem.

#### *Examiner's Proposed Combination of Wildgoose and Knox*

Presumably, the proposed combination of Wildgoose and Knox is to modify Wildgoose's punch guide 51 (see Fig. 1) so that its plate opening 55 possesses a shape similar to the configuration of the guide hole 328 of Knox' bushing 320 which is in the shape of two overlapping round holes, and thereafter utilize this modified punch guide and the rest of Wildgoose's system to surgically prepare a tibia for implantation of a tibial implant in the manner otherwise taught by Wildgoose.

*There Exists No Legitimate Teaching, Suggestion, or Incentive that Supports the Proposed Combination of Wildgoose and Knox*

Presumably, in an attempt to identify a teaching, suggestion, or incentive that would support the above-identified proposed combination of Wildgoose and Knox, the following was stated in the 3/18/04 Office Action (see page 3, lines 1-2; and page 3, lines 6-7):

to create overlapping cuts in the selected tibia plateau.

However, one skilled in the art would not desire *to create overlapping cuts in the selected tibia plateau* since this would result in undesirable impingement of the stem into contact with the cortical bone of the tibia. Indeed, drilling within the tibia to create a space configured as two partially overlapping cylinders, one being on the lateral side of the approximate center point of the tibia, and the other being on the medial side. And in the case of a patient's tibial canal being offset from the approximate center of the tibia, one of these two cylindrical spaces would be created by drilling into a significant amount of cortical bone. Avoiding the creation of a stem space in cortical bone, and thus impingement of the stem into contact with the cortical bone of the tibia, is exactly the problem that Applicants' invention is directed at overcoming.

Thus, modifying Wildgoose's punch guide 51 (see Fig. 1) so that its plate opening 55 possesses a shape of two overlapping round holes, and using such guide to surgically prepare a tibia for implantation of a tibial implant would not have been obvious to one skilled in the art because the apparent use of such a particularly configured guide would not be desirable in the surgical preparation of

a tibia for implantation of a tibial implant. Indeed, using the modified Wildgoose tibial system having such a particularly configured guide in a manner consistent with the teachings of Wildgoose and Knox would arrive at an undesirable surgical result, the type which Applicants' invention is directed at overcoming.

As a result, a legitimate teaching, suggestion, or incentive has not been identified that would support combining Wildgoose and Knox in the manner proposed, nor does one appear to exist. Thus, a prima facie case of obviousness under 35 U.S.C. § 103 has not been established with respect to the invention defined in claim 11.

#### Discussion Re: Patentability of Claims 12-18

Each of claims 12-18 depends directly or indirectly from claim 11. As a result, each of claims 12-18 is allowable for, at least, the reasons hereinbefore discussed with regard to claim 11.

#### Discussion Re: Patentability of Claim 1

The discussion regarding the patentability of claim 11 is relevant to the patentability of claim 1. As a result, claim 1 is allowable over the cited art.

#### Discussion Re: Patentability of Claims 2-10

Each of claims 2-10 depends directly or indirectly from claim 1. As a result, each of claims 2-10 is allowable for, at least, the reasons hereinbefore discussed with regard to claim 1.

#### Discussion Re: Patentability of Claim 19

The discussion regarding the patentability of claim 11 is relevant to the patentability of claim 19. As a result, claim 19 is allowable over the cited art.

#### Discussion Re: Patentability of Claim 20

Claim 20 depends directly from claim 19. As a result, claim 20 is allowable for, at least, the reasons hereinbefore discussed with regard to claim 19.

#### **Newly Added Claims 21-28**

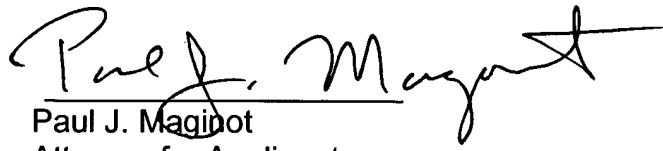
Newly added claims 21-28 recite novel and nonobvious limitations. Thus, each of claims 21-28 is allowable over the cited art.

## Conclusion

In view of the foregoing amendments and remarks, it is submitted that this application is in condition for allowance. Action to that end is hereby solicited.

Respectfully submitted,

MAGINOT, MOORE & BECK

A handwritten signature in black ink, reading "Paul J. Maginot", with a long horizontal flourish extending to the right.

Paul J. Maginot  
Attorney for Applicants  
Registration No. 34,984

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Maginot, Moore & Beck  
Bank One Center/Tower  
111 Monument Circle, Suite 3000  
Indianapolis, Indiana 46204-5115  
Phone: (317) 638-2922  
Fax: (317) 638-2139